

REMARKS

The claims have not been amended. Reconsideration is respectfully requested in view of the following remarks.

Applicants' Response to Rejections
Under 35 U.S.C. §103 over Welch and Young

Claims 1-5 and 7-10 are rejected under 35 U.S.C. § 103(a), as allegedly being obvious over U.S. Patent No. 5,149,441 to Welch, II et al. (hereinafter "Welch") in view of U.S. Patent No. 4,147,821 to Young (hereinafter "Young"). Applicants respectfully traverse the rejection on the basis that the Examiner has failed to establish a prima facie case of obviousness.

The Action contends that Welch discloses a free radical composition, which upon mixing with water is separable therefrom. More particularly, the Action alleges that Welch's composition comprises a (meth)acrylate component and a free radical component, and that the composition has a density different from that of water, thereby allowing for facile separation therefrom when mixed.

The Action admits, however, that the invention defined by of Claims 1-5 and 7-10 is not identically disclosed in Welch. More specifically, the Action admits that Welch fails to disclose that the composition is anaerobically curable. According to the Action, however, Young discloses an anaerobic system in which a combination of a peroxy catalyst and an accelerator is used and in which the impregnant is aerated continuously up until the moment of use. The Action further alleges that a skilled artisan would have been motivated to make the combination of Welch and Young for the reasons explicitly set forth in Young, particularly to have a system that will only set once placed in the pot.

Contrary to the Action's allegations, Welch fails to expressly disclose, teach, or suggest a composition having a density sufficiently different from that of water, thereby allowing facile separation therefrom, as recited in Applicants' claims. Rather, Welch discloses a method for treating wastewater, particularly monomer containing wastewater. The method disclosed in

Welch applies to wastewater produced by aqueous rinsing of porous parts impregnated with a (meth)acrylic acid ester monomer composition. The wastewater is treated to substantially remove the monomer content. The treatment process involves adjusting the pH to a specified value at temperatures below that necessary to effect heat curing, adding a reducing agent to polymerize the monomer, flocculating the polymer, and then physically separating the polymer, e.g., via filtration, from the wastewater effluent. Therefore, Welch teaches a series of steps to effectuate separation of the monomer from the wastewater, not facile separation via differing densities.

In contrast, Applicants' claims are directed to a composition that easily separates from rinse water because its density is sufficiently different from that of water, as well as associated methods of separation. Due to the differing densities, Applicants' composition either floats to the top, or sinks to the bottom, of the rinse water, thereby allowing easy removal thereof. Welch fails to expressly disclose, teach, or suggest such a manner of separation.

The Examiner's rejection over Welch appears to imply that the invention is inherent, and even expressly states so with respect to several claims, but an inherency rejection is only proper in a Section 102 setting, not Section 103. As such, the Examiner's rejection of claims 2, 5, and 11 on the basis of inherency is improper and should be withdrawn.

Even if the Examiner intended the rejection of all claims over Welch to be based on inherency, such a rejection would be improper and Applicants would respectfully traverse. More particularly, Welch discloses numerous methacrylate impregnants, some naturally having densities greater than one and others with densities less than one. However, nowhere in Welch does it require using components having densities sufficiently different from that of water (either lesser or greater). Rather, the disclosure of Welch permits compositions in which several methacrylate components are combined having densities both greater and lesser than water. The resulting composition may have a density similar to that of water. Such a composition would not separate easily from water as its density would not be different enough to cause it to sink or float in rinse water. Therefore, the compositions of Welch do not necessarily possess the

characteristics of the presently claimed invention, making an inherency rejection improper. *See* MPEP § 2112.01.

Moreover, Young is cited only for its disclosure of an anaerobic system and fails to teach or suggest anything of relevance to the present invention as recited in Applicants' claims. Therefore, Young fails to cure the deficiencies of Welch.

As such, contrary to the Action's allegations, the combination of Welch and Young fails to disclose each and every element of the invention recited in Claims 1-5 and 7-10. Moreover, neither Welch nor Young contains any express disclosure that would suggest Applicants' compositions. Further neither Welch nor Young provide any motivation to combine the teachings of the other, let alone to reach the recitations of the rejected claims. Accordingly, Claims 1-5 and 7-10 are not obvious in view of the teachings of Welch in combination with Young. Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection based on this combination.

Applicants' Response to Rejections
Under 35 U.S.C. §103 over Welch, Young, and Muisener

Claim 6 is rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Welch and Young in view of U.S. Patent No. 5,006,233 to Muisener (hereinafter "Muisener"). Applicants respectfully traverse the rejection on the basis that the Examiner has failed to establish a prima facie case of obviousness.


Claim 6 further defines Applicants' composition as having a density less than that of water. The Action admits that the subject matter of Claim 6 is not identically disclosed in Welch. The Action, however, contends that Claim 6 is obvious over Welch and Young in view of Muisener. The Action alleges that Muisener teaches a floating composition, particularly in Claim 21 with respect to the use of a gravimetric separation filter. The Action further alleges that a skilled artisan would have been motivated to make the combination of Welch, Young, and Muisener for the reasons set forth in Muisener, particularly to facilitate reduced rinse water consumption through recycling.

In addressing Welch and Young as references, Applicants have already described in detail that the combination fails to provide (either expressly or inherently) or even suggest a composition as in Applicants' claims. Moreover, Muisener fails to expressly disclose, teach, or suggest the allegedly missing subject matter of Claim 6. Rather, Muisener teaches the processing of an acrylate emulsion to the resulting formed polymer and filtration removal of that same polymer. In particular, Muisener relates to an apparatus for purifying rinse water containing a monomer emulsion and a photoinitiator. The apparatus includes: curing means for exposing the rinse water to UV energy to polymerize the acrylate emulsion, means for directing the flow of rinse water containing the emulsion past the curing means; and means for filtering the rinse water to remove the polymer therefrom. Therefore, Muisener teaches purification by recovery of a processed polymer from rinse water.

As such, contrary to the Action's allegations, Muisener fails to cure the deficiencies of Welch and Young as a combination. Neither Welch nor Young nor Muisener contains any express disclosure that would teach or suggest Applicants' compositions. Further none of the references provide any motivation to combine the teachings of the other, let alone to reach the recitations of the rejected claim. Accordingly, Claim 6 is not obvious in view of the teachings of Muisener and Young in combination with Welch. Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection based on this combination.

Applicants' undersigned attorney may be reached by telephone at the number given below. All correspondence should continue to be directed to the address given below.

Respectfully submitted,



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